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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
09/880,757	06/15/2001	Kiyotaka Wasa	35.C15462	5938	
5514	7590 02/26/2003				
FITZPATRICK CELLA HARPER & SCINTO			EXAMINER		
<del>-</del>	ELLER PLAZA C, NY 10112		TUGBANG, ANTHONY D		
			ART UNIT	PAPER NUMBER	
			3729		
		DATE MAILED: 02/26/2003			

Please find below and/or attached an Office communication concerning this application or proceeding.

				<u> </u>				
•	Application No.		Applicant(s)	70				
065 - 4 - 4 0	09/880,757	1	WASA ET AL.					
Office Action Summary	Examiner		Art Unit					
	Dexter Tugbang		3729					
The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply								
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.  - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).  - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).								
1) Responsive to communication(s) filed on 24 C	October 2002 and	l 23 December 2	<u>002</u> .					
	s action is non-fi							
3) Since this application is in condition for allowa				e merits is				
closed in accordance with the practice under language of Claims	Ex parte Quayle,	1935 C.D. 11, 4	53 O.G. 213.					
4)⊠ Claim(s) 24-28 and 61-83 is/are pending in the application.								
4a) Of the above claim(s) is/are withdraw	vn from consider	ation.		•				
5) Claim(s) is/are allowed.								
6)☐ Claim(s) is/are rejected.								
<u> </u>	7) Claim(s) is/are objected to.							
8) Claim(s) 24-28 and 61-83 are subject to restriction and/or election requirement.								
Application Papers								
9) The specification is objected to by the Examiner.								
10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner.								
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  11) The proposed drawing correction filed on is: a) approved b) disapproved by the Examiner.								
If approved, corrected drawings are required in reply to this Office action.								
12) The oath or declaration is objected to by the Examiner.								
Priority under 35 U.S.C. §§ 119 and 120								
13)⊠ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).								
a)⊠ All b)□ Some * c)□ None of:								
1.⊠ Certified copies of the priority documents have been received.								
2. Certified copies of the priority documents have been received in Application No								
Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  * See the attached detailed Office action for a list of the certified copies not received.								
14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).								
a) The translation of the foreign language provisional application has been received.  15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.								
Attachment(s)								
1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s)		Notice of Informal P	(PTO-413) Paper No( atent Application (PT					

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## **DETAILED ACTION**

## Election/Restrictions

- 1. The preliminary amendments filed 10/24/02 and 12/23/02 (Paper Nos. 10, 12), particularly the additional new claims, has necessitated the following action.
- 2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 24-28 and 61-72, drawn to a process of making a liquid discharge recording head, classified in class 29, subclass 890.1.
  - II. Claims 73-83, drawn to a process of making a piezoelectric structure, classified in class 29, subclass 25.35.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions of Groups II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination (Group II) as claimed does not require the particulars of the subcombination (Group I) as claimed because Group II does not require the specifics of a liquid discharge recording head or a vibrating plate, or removal of any substrate. The subcombination (Group I) has separate utility such as a piezoelectric structure not in a liquid discharge recording head, for example, a magnetic head piezoelectric structure.

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- 4. Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.
- 5. If applicants' elect the invention of Group I, this application contains claims directed to the following patentably distinct species of the claimed invention:

Species A, Claims 24, 26, 27 and 61-67; and

Species B, Claims 25, 28 and 68-72.

NOTE: Species A does not require the specifics of removing a supporting substrate, as required by Species B. Species B does not require the specifics of dividing the piezoelectric film into portions corresponding to pressure chambers. Thus, Species A is mutually exclusive from Species B.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, there are no generic Claims in the invention of Group I.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after

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the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. A telephone call was made to Mr. Doug Pinsky on February 21, 2003 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

- 7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).
- 8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dexter Tugbang whose telephone number is 703-308-7599. The examiner can normally be reached on Monday Friday 9:00 am 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 703-308-1789. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-305-3590 for regular communications and 703-305-3588 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

Dexter Tugbang

Examiner

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adt

February 24, 2003